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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
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09/921,803

08/03/2001

Hugh James O'donnell

OT-4812

8340

26096 7590 03/09/2007
CARLSON, GASKEY & OLDS, P.C.
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BIRMINGHAM, MI 48009

EXAMINER

KRUEER, STEFAN

ART UNIT

PAPER NUMBER

3654

MAIL DATE

DELIVERY MODE

03/09/2007

PAPER

Please find below and/or attached an Office communication concerning this application or proceeding.

**Advisory Action
Before the Filing of an Appeal Brief**

Application No.

09/921,803

Applicant(s)

O'DONNELL ET AL.

Examiner

Stefan Kruer

Art Unit

3654

--The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

THE REPLY FILED 22 February 2007 FAILS TO PLACE THIS APPLICATION IN CONDITION FOR ALLOWANCE.

1. ☒ The reply was filed after a final rejection, but prior to or on the same day as filing a Notice of Appeal. To avoid abandonment of this application, applicant must timely file one of the following replies: (1) an amendment, affidavit, or other evidence, which places the application in condition for allowance; (2) a Notice of Appeal (with appeal fee) in compliance with 37 CFR 41.31; or (3) a Request for Continued Examination (RCE) in compliance with 37 CFR 1.114. The reply must be filed within one of the following time periods:

- a) ☒ The period for reply expires 3 months from the mailing date of the final rejection.
b) ☐ The period for reply expires on: (1) the mailing date of this Advisory Action, or (2) the date set forth in the final rejection, whichever is later. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the mailing date of the final rejection.

Examiner Note: If box 1 is checked, check either box (a) or (b). ONLY CHECK BOX (b) WHEN THE FIRST REPLY WAS FILED WITHIN TWO MONTHS OF THE FINAL REJECTION. See MPEP 706.07(f).

Extensions of time may be obtained under 37 CFR 1.136(a). The date on which the petition under 37 CFR 1.136(a) and the appropriate extension fee have been filed is the date for purposes of determining the period of extension and the corresponding amount of the fee. The appropriate extension fee under 37 CFR 1.17(a) is calculated from: (1) the expiration date of the shortened statutory period for reply originally set in the final Office action; or (2) as set forth in (b) above, if checked. Any reply received by the Office later than three months after the mailing date of the final rejection, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

NOTICE OF APPEAL

2. ☐ The Notice of Appeal was filed on _____. A brief in compliance with 37 CFR 41.37 must be filed within two months of the date of filing the Notice of Appeal (37 CFR 41.37(a)), or any extension thereof (37 CFR 41.37(e)), to avoid dismissal of the appeal. Since a Notice of Appeal has been filed, any reply must be filed within the time period set forth in 37 CFR 41.37(a).

AMENDMENTS

3. ☐ The proposed amendment(s) filed after a final rejection, but prior to the date of filing a brief, will not be entered because
(a) ☐ They raise new issues that would require further consideration and/or search (see NOTE below);
(b) ☐ They raise the issue of new matter (see NOTE below);
(c) ☐ They are not deemed to place the application in better form for appeal by materially reducing or simplifying the issues for appeal; and/or
(d) ☐ They present additional claims without canceling a corresponding number of finally rejected claims.

NOTE: _____. (See 37 CFR 1.116 and 41.33(a)).

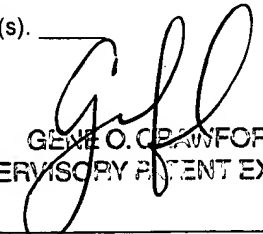
4. ☐ The amendments are not in compliance with 37 CFR 1.121. See attached Notice of Non-Compliant Amendment (PTOL-324).
5. ☐ Applicant's reply has overcome the following rejection(s): _____.
6. ☐ Newly proposed or amended claim(s) _____ would be allowable if submitted in a separate, timely filed amendment canceling the non-allowable claim(s).
7. ☐ For purposes of appeal, the proposed amendment(s): a) ☐ will not be entered, or b) ☐ will be entered and an explanation of how the new or amended claims would be rejected is provided below or appended.
The status of the claim(s) is (or will be) as follows:
Claim(s) allowed: _____.
Claim(s) objected to: _____.
Claim(s) rejected: _____.
Claim(s) withdrawn from consideration: _____.

AFFIDAVIT OR OTHER EVIDENCE

8. ☐ The affidavit or other evidence filed after a final action, but before or on the date of filing a Notice of Appeal will not be entered because applicant failed to provide a showing of good and sufficient reasons why the affidavit or other evidence is necessary and was not earlier presented. See 37 CFR 1.116(e).
9. ☐ The affidavit or other evidence filed after the date of filing a Notice of Appeal, but prior to the date of filing a brief, will not be entered because the affidavit or other evidence failed to overcome all rejections under appeal and/or appellant fails to provide a showing of good and sufficient reasons why it is necessary and was not earlier presented. See 37 CFR 41.33(d)(1).
10. ☐ The affidavit or other evidence is entered. An explanation of the status of the claims after entry is below or attached.

REQUEST FOR RECONSIDERATION/OTHER

11. ☒ The request for reconsideration has been considered but does NOT place the application in condition for allowance because:
See Continuation Sheet.
12. ☐ Note the attached Information Disclosure Statement(s). (PTO/SB/08) Paper No(s). _____
13. ☐ Other: _____.


GENE O. CRAWFORD
SUPERVISORY PATENT EXAMINER

Continuation of 11. does NOT place the application in condition for allowance because: Wilcox discloses his lubricants as one of several synthetic lubricants, including but not limited to PTFE and polypropylene, as recognized as one of several lubricants that have "... the similar effects and performance..." (Line 1 and Table 2, Pg. 2) as "natural occurring waxes" (Exhibit A, Pg. 1) of the reference filed on 17 October 2006 by the applicant under affidavit/request for continued examination.

With respect to applicant's assertion that the use of his specification to define the term "waxless" has no basis in law, applicant has not referenced a case law whereby the use of the specification to define a term of the claim language is improper. The specification of the instant invention is limiting in its disclosure as to a specific family or type of waxes that are to be precluded as "...typical stearate-based waxes that are routinely added to urethane materials..." (Para. 14). Therefore, applicant's "waxless" urethane coating is a coating absent of stearate-based waxes.

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FEB 22 2007

60469-037
OT-4812

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

In re application: O'Donnell, et al.
Serial No.: 09/921,803
Filed: 08/03/2001
Group Art Unit: 3654
Examiner: Kruer, Stefan
For: ELEVATOR BELT ASSEMBLY WITH WAXLESS COATING

REQUEST FOR RECONSIDERATION

Mail Stop AF
Commissioner for Patents
P. O. Box 1450
Alexandria, VA 22313-1450

Dear Sir:

This is responsive to the Office Action mailed on December 29, 2006. Applicant respectfully requests reconsideration of this application.

The Examiner's interpretation of the *Wilcox* reference is directly contrary to the express teachings of that reference. It appears from the Final Office Action that the Examiner is acknowledging that *Wilcox* discloses a wax. Therefore, it is impossible to interpret that reference as disclosing a waxless urethane.

The Examiner's comments on page 4 regarding a hypothetical limitation on Applicant's claimed waxless urethane based on a statement in the specification has no basis in law and does not provide any reason to maintain the rejections against Applicant's claims.

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There is no *prima facie* case of anticipation or obviousness against any of Applicant's claims. The rejections must be withdrawn and this case should be allowed.

Respectfully submitted,

CARLSON, GASKEY & OLDS

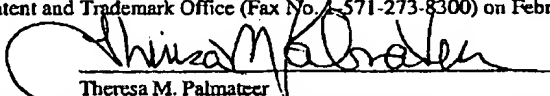
By: 

David J. Gaskey
Registration No. 37,139
400 W. Maple Rd., Ste. 350
Birmingham, MI 48009
(248) 988-8360

Dated: February 22, 2007

CERTIFICATE OF FACSIMILE

I hereby certify that this Request for Reconsideration, relative to Application Serial No. 09/921,803, is being facsimile transmitted to the Patent and Trademark Office (Fax No. 571-273-8300) on February 22, 2007.


Theresa M. Palmateer

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